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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,202	07/09/2003	Susumu Kawashima	2552-000044	9771
27572	7590	10/06/2006	EXAMINER	
HARNESS, DICKEY & PIERCE, P.L.C.			WARREN, DAVID S	
P.O. BOX 828			ART UNIT	
BLOOMFIELD HILLS, MI 48303			PAPER NUMBER	
			2837	

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/616,202		KAWASHIMA, SUSUMU	
	<b>Examiner</b>		<b>Art Unit</b>	
	David S. Warren		2837	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 10-12 is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/22/06, 9/8/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 7 - 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As per MPEP 2106 (IV)(B)(1)(a), the claims must positively recite a "computer-readable medium" and not merely a computer program per se. For the Applicant's convenience, the appropriate section of the MPEP is as follows:

Since a computer program is merely a set of instructions capable of being executed by a computer, the computer program itself is not a process and Office personnel should treat a claim for a computer program, **without the computer-readable medium** needed to realize the computer program's functionality, as **nonstatutory functional descriptive material**.  
[Emphasis added.]

### ***Allowable Subject Matter***

7. Claims 1 – 6 and 10 – 12 are allowed. Regarding claims 1 – 4, (this also applies to claims 7 and 8 if the Applicant overcomes the §101 rejection discussed supra) the prior art does not disclose a client-server arrangement where the client selects whether performance data is converted to audio data on the client or on the server. Regarding claims 5 and 6 (and claim 9 if the §101 rejection is obviated), the prior art does not

disclose converting performance data into audio data in accordance with a setting parameter and automatically deleting the performance data from a temporary storage medium. Regarding claims 10 – 12, the prior art does not disclose server-side conversion of performance data in accordance with a client supplied setting parameter.

8. The Examiner notes that, as the recently cited Information Disclosure Statements indicate, that conversion from performance data to audio data is very well known.

Furthermore, server-side conversion is known. In the Examiner's view, the novelty of the instant Application is that a client has control as to whether the conversion takes place on the server or client, that conversion can take place on the server in accordance with a setting parameter received from the client, or that conversion can take place on the client in accordance with a setting parameter and that the performance data is deleted automatically from a temporary storage after conversion to audio. The Examiner also, in contrast to cited foreign Office Actions, does not consider the setting parameter to be "a type of mobile terminal" nor merely the request itself (the claims recite both a request and a setting parameter – and the specification clearly makes this distinction).

### ***Information Disclosure Statement***

The Information Disclosure Statement submitted on August 22, 2006 was inadvertently left blank. In writing this Office Action, the Examiner considered all documents submitted with the IDS. The Applicant is requested to submit a proper IDS.


### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Examiner cites Krueger (6,308,222) to show that conversion can take place on the server, but Krueger is silent as to any client-side setting parameter to modify the conversion (note elements 601 and 612 in Krueger's fig. 6).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David S. Warren whose telephone number is 571-272-2076. The examiner can normally be reached on M-F, 9:30 A.M. to 6:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on 571-272-2837. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
LINCOLN DONOVAN  
SUPERVISORY PATENT EXAMINER